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*3723  
Election  
12/10/03*

Application No.: 09/998,372

Docket No.: 005917/USA/FET/FET

Certificate of Mailing: Date of Deposit: December 4, 2003

I hereby certify under 37 C.F.R. § 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Janet McKean

Printed name of person mailing correspondence

*Janet McKean*

Signature of person mailing correspondence

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Young Joseph PAIK

Serial No. 09/998,372

Filed: November 30, 2001

Group Art Unit: 3723

Examiner: Robert A. Rose

For: CONTROL OF A CHEMICAL MECHANICAL POLISHING PAD CONDITIONER  
DIRECTIONAL VELOCITY TO IMPROVE PAD LIFE

**RESPONSE TO RESTRICTION REQUIREMENT**

Honorable Commissioner for Patents  
Alexandria, VA 22313-1450

Sir:

This communication is in response to the Office Action mailed November 4, 2003,  
having a one-month shortened statutory period of response set to expire by December 4, 2003.  
The following remarks are respectfully submitted.

**PROVISIONAL ELECTION**

Applicant hereby provisionally elects Group I (claims 1-17, 22-32, and 40) for  
prosecution, with traverse.

**TRAVERSE**

The restriction requirement is respectfully traversed, for the following reasons: (1) the restriction is improper since reasonable examples of material differences were not provided; and (2) there appears to be no serious burden on the Examiner necessitating the restriction requirement.

Regarding (1) above, the Examiner cited MPEP § 806.05(e), which states that inventions are distinct if it “can be shown: (A) the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process.” The Examiner then appeared to indicate that the former of these two (i.e., “(A)”) was applicable to the present application. However, it was not made clear by the Examiner why this would be the case. In particular, no examples were provided by the Examiner other than to note that the calculations could be done manually, which would be impractical, if not impossible, on the timescale of the polishing process. Specifically, MPEP § 806.05(e) states that “the burden is on the examiner to provide reasonable examples that recite material differences.” *Id.* Consequently, should the Examiner maintain the restriction, Applicant respectfully submits that such examples be provided.

Regarding (2) above, the Restriction Requirement cited class/subclass combinations to search:

- Group I: 451/21 (Abrading/Process having tool wear compensation)
- Group II: 451/72 (Abrading/Apparatus having means to refurbish abrading tool)

It is believed that the search for Group II is not well taken as a material difference, since both restriction groups relate to abrading and abrasion tool compensation. Hence, it is respectfully submitted that class/subclass 451/21 could be searched for both restriction groups. Consequently, there appears to be no serious burden on the Examiner necessitating the restriction requirement, as would be required as indicated in the introductory paragraphs of MPEP § 803.

For the reasons given above, the Examiner is respectfully requested to reconsider and withdraw the restriction requirement.

### AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees should any be required for this submission, or credit any overpayment to deposit account no. 08-0219.

In the event that an Extension of Time is required, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,  
HALE AND DORR LLP



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